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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058912
Party	Defendant Cary D. Portner
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

PHARMAVITE, LLC

Petitioner

Cancellation No. 92058912

Mark: Naturally Made

Reg. No. 4,496,443

IC: 030 Tea based beverages; Iced Tea

v.

CARY D. PORTNER

Respondent.

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**RESPONDENT’S REPLY IN SUPPORT OF MOTION TO SUSPEND CANCELLATION  
PROCEEDING PENDING OUTCOME OF BOARD OPPOSITION PROCEEDING**

Respondent, Cary D. Portner (“Respondent”), by and through his undersigned attorney, hereby submits his Reply in Support of his Motion to Suspend Cancellation Proceeding Pending Outcome of Board Opposition Proceeding (“Reply”) and states as follows:

**I. Suspension Based On A Pending Board Matter Is Appropriate And Authorized By The Rules**

The plain language of the TTAB Rules (“Rules”) and the TBMP make it perfectly clear that the Board has discretion to suspend a proceeding when a party is engaged in another pending Board proceeding that may have a bearing on the case. *See* 37 C.F.R. §2.117(a) and TBMP §510.02(a).<sup>1</sup> Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceedings *may have a bearing* on the issues before the Board. TBMP §510.02(a) [Note 7]. [Emphasis added]

Petitioner’s statement that related civil litigation is the “most proper” scenario for suspension is neither warranted nor implied by the Rules or the TBMP.<sup>2</sup>

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<sup>1</sup> Suspension of a Board proceeding pending the final determination of another proceeding is

<sup>2</sup> *See* Petitioner Pharmavite, LLC’s Brief Opposing Respondent’s Motion to Suspend (p. 2).

Notably, Petitioner fails to cite even a single case in which a motion to suspend a Board proceeding, based on another pending Board proceeding, was denied.

Further, neither the Rules nor the TBMP require the “other proceeding” to be entirely dispositive of the Board proceeding to warrant suspension. The other proceeding need only possibly have a bearing on the issues before the Board. 37 C.F.R. §2.117(a)

## **II. Petitioner’s Allegations Warrant Dismissal Of The Instant Cancellation**

Petitioner claims Registrant’s **NATURALLY MADE** mark that is the subject of the Cancellation is “entirely different” from Del Monte’s **NATURE MADE** mark that is the subject of the Opposition.<sup>3</sup> However, the Cancellation proceeding is based on Petitioner’s allegation that Registrant’s **NATURALLY MADE** mark is so similar to Petitioner’s **NATURE MADE** marks that it is likely to cause confusion. *See* Pharmavite, LLC’s Petition to Cancel, (¶6, p.3).

If it is indeed Petitioner’s contention that **NATURALLY MADE** and **NATURE MADE** are two entirely different marks, then the instant Cancellation should not merely be suspended, it should be dismissed.

## **III. Claims of Likelihood of Confusion And Dilution Are Alleged In Both Cancellation and Opposition Proceedings**

Petitioner alleges that dilution and confusion is likely to result to its **NATURE MADE** marks as a consequence of Del Monte’s use of **NATURE MADE** for various food and beverage items<sup>4</sup>, and Respondent’s use of **NATURALLY MADE** for tea based beverages and iced tea.<sup>5</sup>

Despite common substantive claims involving related issues of fact and law, Petitioner alleges that suspension of the Cancellation is not warranted, since the Cancellation also involves additional claims of fraud and non-use.<sup>6</sup>

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<sup>3</sup> *Supra* Note 2 at pp. 2-3.

<sup>4</sup> *See* Respondent’s Motion to Suspend Cancellation, Exh. C (¶¶ 2, 5, 13-16)

<sup>5</sup> *See* Pharmavite, LLC’s Petition to Cancel, (¶¶ 2, 3, 6, 10)

However, neither the Rules nor the TBMP require that the other proceeding reflect a mirror image of the claims or even a complete disposition of *some* of the claims.

Rather, the standard articulated is clear: The Board will suspend proceedings in the case before it if the final determination of the other proceedings may have a bearing on the issues before the Board. TBMP §510.02(a) [Note 7]. [Emphasis added]

#### **IV. The Same Claim Of Fame Of Petitioner's Marks Is Alleged In Both The Cancellation and Opposition**

It is within the Board's purview to rule on whether the evidence presented supports Petitioner's allegation relating to the fame of its **NATURE MADE** marks. Certainly, the expectation is that Petitioner will introduce the same evidence to support its allegation of fame in both proceedings. If it is Petitioner's contention that it will offer different evidence in the Opposition proceeding than in the Cancellation relating to the alleged fame of its **NATURE MADE** marks – such a claim is disingenuous.<sup>7</sup>

Petitioner has placed the issue of the fame of its **NATURE MADE** marks in dispute in both proceedings. Accordingly, it is beyond question that a final determination relating to the fame of the **NATURE MADE** marks in the Opposition proceeding may have a bearing on the issues before the Board in the present Cancellation.

#### **V. The Opposition Includes The Same Reference Marks Cited By Petitioner In The Cancellation**

Petitioner relies on a common set of reference marks to support its allegations of

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<sup>6</sup> *Supra* Note 2 at p. 3

<sup>7</sup> Additionally Petitioner notes that the instant action is a Cancellation proceeding and the other proceeding is an Opposition. However, this is a distinction without a difference. Neither the rules nor the TBMP deem this a relevant consideration.

likelihood of confusion, dilution and fame, in both Cancellation and Opposition proceedings.<sup>8</sup>

If Petitioner fails in its Opposition of Del Monte's **NATURE MADE** mark, Serial No. 85/254809, then it will, in turn, have to present argument in the prosecution of its pending marks cited as references in the Cancellation, namely, Serial Nos. 85/862,772; 85/862,774; 85/862,776, in order to overcome the Examiner's provisional Section 2(d) likelihood of confusion refusals.<sup>9</sup> That will be an interesting argument indeed.

It is Petitioner's contention that "regardless of the outcome, Petitioner may proceed with (i) its pending applications..."<sup>10</sup> Petitioner's argument is disingenuous. Petitioner argues that for the purpose of the Opposition there is a Section 2(d) likelihood of confusion. It will have to adopt a contrary position in order to overcome the Section 2(d) likelihood of confusion provisional rejection in the prosecution of Serial Nos. 85/862,772; 85/862,774; 85/862,776, if its Opposition fails, namely that there is not a Section 2(d) likelihood of confusion.

The Opposition will clearly impact the prosecution and viability of three of the reference marks cited in the Cancellation, namely, Serial Nos. 85/862,772; 85/862,774; 85/862,776. Thus, it is beyond dispute that a final determination in the Opposition may have a bearing on the issues before the Board in the present Cancellation.

#### **VI. There Is Good Cause To Suspend The Cancellation Since the Pending Opposition Has A Bearing On The Issues Before The Board**

In support of its argument Petitioner notes differences between the Opposition and the Cancellation, including the fact that Respondent's mark is registered on the Supplemental

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<sup>8</sup> Serial Nos. 85/862,774 - 85/862772 - 85/862776. Registration Nos. 2,753,799 - 1,963,505 - 3,520,080 - 3,844,128 - 3,883,440 - 4,036,212 - 3,861,557 - 3,990,403 - 3,761,805 - 4,071,864.

<sup>9</sup> *Supra* note 4, pp.2-3, ¶¶ 7-10.

<sup>10</sup> *Supra* note 2, at p.4.

Register and the Opposition involves pending applications for registration on the Principal Register.<sup>11</sup>

Petitioner also points to the fact that the present proceeding is a Cancellation, whereas the other proceeding is an Opposition.<sup>12</sup>

Both distinctions are entirely irrelevant. The only relevant consideration is whether a final determination in the other proceeding may have a bearing on the issues before the Board. *See* 37 C.F.R. §2.117(a) and TBMP §510.02(a). Neither the Rules nor the TBMP impose limitations requiring identical proceedings or registration types.

Petitioner also argues that the Opposition involves various food and beverage items but does not involve Respondent's tea based beverages and iced tea.<sup>13</sup>

However, Petitioner fails to consider that by the same token, its own goods are different from both the goods in the Opposition and the present Cancellation. Hence, this too is a distinction without a difference.

The other proceeding does not have to be entirely dispositive of the Board proceeding to warrant suspension. It does not require an identity of issues. Nor does it require the other proceeding be an action pending in district court. It only requires that the other proceeding may have a bearing on the issues before the Board. Trademark Rule 2.117(a).

The common claims in the Opposition and Cancellation indicate that duplicative issues and evidence may be submitted. A final determination in the Opposition will certainly have a bearing on the issues before the Board in the Cancellation. Thus, interest in consistency and economy favors suspension, pending final disposition of the Opposition.

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<sup>11</sup> *Supra* note 2, at p.3.

<sup>12</sup> *Supra* note 2 at p.3.

<sup>13</sup> *Supra* note 2 at p. 3

### **Conclusion**

For the reasons set forth above, Respondent respectfully requests that the Board suspend the Cancellation until final disposition of the Opposition between Petitioner and Del Monte Fresh Produce N.A., Inc.

Dated: June 2, 2014

Respectfully submitted,

/Jacqueline Tadros/\_\_\_\_\_  
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### **CERTIFICATE OF SERVICE**

**I HEREBY CERTIFY** that pursuant to Rule 2.101(b) of the Trademark Rules of Practice, that I have this day served the foregoing, RESPONDENT'S REPLY IN SUPPORT OF MOTION TO SUSPEND CANCELLATION PENDING OUTCOME OF BOARD PROCEEDING on Petitioner by causing a true and correct copy thereof via first class U.S. Mail, today, June 2, 2014, postage prepaid, addressed to Applicant as follows:

Pete Bromaghim  
**Blakely Sokoloff Taylor Zafman, LLP**  
12400 Wilshire Blvd.  
Los Angeles, CA 90025

/Jacqueline Tadros/\_\_\_\_\_  
Jacqueline Tadros